

3. Remarks.

Claims 3-7 and 10-14 have been canceled without prejudice or disclaimer, and, claims 1 and 8 have been amended.

Alter respectfully requests further examination and reconsideration of claims 1, 2, 8, and 9, now pending in the application.

If the specification and/or claims should require any further amendment, the kind assistance of the Examiner in entering an Examiner's Amendment would be gratefully appreciated.

The last Office action mailed from the Patent Office on October 3, 2005 has been carefully considered, and indicates that:

- claims 1, 3, 4, 8, 10, and 11 are rejected under 35 U.S.C. § 102(b) as being anticipated by Melin *et al.*; and
- claims 1-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wareheim in view of Hull.

A. The Examiner's Rejection of Claims 1, 3, 4, 8, 10, and 11 under 35 U.S.C. § 102(b) as Being Anticipated by Melin *et al.*, and, the Examiner's Rejection of Claims 1-14 under 35 U.S.C. § 103(a) as Being Unpatentable over Wareheim in View of Hull.

In response to the Examiner's rejection of claims 1, 3, 4, 8, 10, and 11 under 35 U.S.C. § 102(b) as being anticipated by Melin *et al.*, and, the Examiner's rejection of claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over Wareheim in view of Hull, Alter has:

- canceled claims 3-7 and 10-14 without prejudice or disclaimer;

- amended claim 1 to include the limitations of canceled claims 3-7; and
- amended claim 8 to include the limitations of canceled claims 10-14.

Alter respectfully submits that under 37 CFR § 1.111(c), each of amended claims 1 and 8 describe the following advantageous distinctive features that distinguish over, and avoid, the prior art:

- a) “said border is a tape”;
- b) “said tape of said border is affixed to any wall of said honeycomb core of said shelf that it comes in contact with, especially any defining an open cell of said honeycomb core of said shelf located at said periphery of said shelf”;
- c) “[said tape of said border] folds over to be affixed to said upper skin of said shelf and said lower skin of said shelf”;
- d) “said inserts are tapes”;
- e) “said tapes of said inserts are affixed to any wall of said honeycomb core of said shelf that they come in contact with, especially any defining an open cell of said honeycomb core of said shelf caused by a through bore through said shelf”; and
- f) “[said tapes of said inserts] fold over to be affixed to said upper skin of said shelf and said lower skin of said shelf”.

When the lightweight, structurally integral, and strong composite rack shelving of the present invention is designed in accordance with these advantageous distinctive features, *inter alia*:

- any shaped border can be conformed to and covered, *ipso facto*, “said border is a tape”;
- the structural integrity of the shelf is maintained by closing off any open cell of the honeycomb core of the shelf located at the periphery of the shelf and allow the border to form a structurally integral unit with the shelf, *ipso facto*, “said tape of said border is affixed to any wall of said honeycomb core of said shelf that it comes in contact with, especially any defining an open cell of said honeycomb core of said shelf located at said periphery of said shelf * * * and which folds over to be affixed to said upper skin of said shelf and said lower skin of said shelf”;
- “exposure to any of the honeycomb core [at the border] that typically contains rigid and sharp edges [is covered]”,¹ *ipso facto*, “said tape of said border is affixed to any wall of said honeycomb core of said shelf that it comes in contact with, especially any defining an open cell of said honeycomb core of said shelf located at said periphery of said shelf * * * and which folds over to be affixed to said upper skin of said shelf and said lower skin of said shelf”;
- “the core [at the border] is [is provided with] protection from outside elements, including fire,”² *ipso facto*, “said tape of said border is affixed to any wall of said honeycomb core of said shelf that it comes in contact with, especially any defining an open cell of said honeycomb core of said shelf located at said periphery of said shelf * * * and which folds over to be affixed to said upper skin of said shelf and said lower skin of said shelf”;
- any shaped through bore can be conformed to and bordered, *ipso facto*, “said inserts are tapes”;
- the structural integrity of the shelf is maintained by closing off any open cell of the honeycomb core of the shelf caused by a through bore through the shelf and allow the inserts to form a structurally integral unit with the shelf, *ipso facto*, “said tapes of said inserts are affixed to any wall of said honeycomb core of said shelf that they come in contact with, especially any defining an open cell of said honeycomb core of said shelf caused by a through bore through said shelf * * * and which fold over to be affixed to said upper skin of said shelf and said lower skin of said shelf”;

¹ Office action at page 6, ¶ 2, lines 8-9.

² *Id.* at lines 9-11.

- “exposure to any of the honeycomb core [at the through bores] that typically contains rigid and sharp edges [is covered]”,³ *ipso facto*, “said tapes of said inserts are affixed to any wall of said honeycomb core of said shelf that they come in contact with, especially any defining an open cell of said honeycomb core of said shelf caused by a through bore through said shelf * * * and which fold over to be affixed to said upper skin of said shelf and said lower skin of said shelf”;
- “the core [at the through bores] is [is provided with] protection from outside elements, including fire,”⁴ *ipso facto*, “said tapes of said inserts are affixed to any wall of said honeycomb core of said shelf that they come in contact with, especially any defining an open cell of said honeycomb core of said shelf caused by a through bore through said shelf * * * and which fold over to be affixed to said upper skin of said shelf and said lower skin of said shelf”; and
- “the overall system [is allowed] to retain the high strength-to-weight ratio inherent in the honeycomb core”.⁵

The Examiner suggests “that [i]t would have been * * * obvious to include [an] adhesive film as disclosed by Hull as a border of *both* the outside periphery *and* the inner throughbores of the honeycomb shelf as disclosed by Wareheim in view of Hull * * *.”⁶ From this, it is apparent that the Examiner has taken facts beyond the record, which is contrary to the PTO policy in *MPEP* § 706.02(a) directing Examiners never to overlook the importance of allowing claims that properly define patentable subject matter. “Facts beyond the record

³ See *Id.* at lines 8-9.

⁴ See *Id.* at lines 9-11.

⁵ *Id.* at lines 13-14.

⁶ *Id.* at lines 4-6.

should not be evidence upon which a rejection is based.”⁷ Thus, it is improper, if not inequitable, for the Examiner to rely on this fact for evidence of the rejection.

Furthermore, the Examiner is not obligated to find such a rejection simply to be able to reject every claim in the application. If it would have been so obvious to include the adhesive film as disclosed by Hull as a border of *both* the outside periphery *and* the inner throughbores of the honeycomb shelf as disclosed by Wareheim in view of Hull, why then did Wareheim not already do it?

“Without * * * concrete evidence neither the applicant nor the Examiner can make a proper determination of the state of the art or the issues relevant to either anticipation or obviousness, nor can the applicant fairly judge whether the prior art discloses the claimed invention, is capable of being combined with the other references, or is in an analogous field of art.”⁸ Thus, if the Examiner still maintains such a rejection, Alter respectfully requests that the Examiner provide a reference that shows the advantageous distinctive features of amended claims 1 and 8 discussed above or an affidavit detailing the Examiner’s knowledge as one of ordinary skill in the art to which the present invention pertains affirming “that [i]t would have been * * * obvious to include [an] adhesive film as disclosed by Hull as a border of *both* the

⁷ *In re Ahlert*, 165 USPQ 418, 420 (CCPA 1970); *See In re Howard*, 394 F.2d 869, 872 (CCPA 1968) (“I do not see how, without any evidence, we can use the doctrine of judicial notice to find that a system exists which anticipates that of the application or is nearly like it as to make the application an obvious variation * * *. Without some concrete evidence (of which there is none) I do not think that it is possible to find that the system of this application is old or that it is obvious under Section 103.”).

⁸ *In re Newell*, 13 USPQ.2d 1248 (CAFC 1989).

outside periphery *and* the inner throughbores of the honeycomb shelf as disclosed by Wareheim in view of Hull * * *”, because *CFR § 1.107(b)* provides that “[w]hen a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.”

4. Conclusion.

The Examiner has overlooked the importance of allowing claims that properly define patentable subject matter, just to be able to reject every claim in the application. The Examiner has improperly and inequitably taken facts beyond the record as evidence for the rejections. Without either a proper reference teaching the claimed invention or an affidavit affirming the Examiner’s knowledge as one skilled in the art to which the claims are directed, the rejections cannot stand. Thus, in view of the cancellation of claims 3-7 and 10-14 without prejudice or disclaimer, the amendment made to claim 1 to include the limitations of canceled claims 3-7, the amendment made to claim 8 to include the limitations of canceled claims 10-14, and the arguments presented, Alter respectfully submits that the Examiner’s grounds for the rejection of claims 1, 3, 4, 8, 10, and 11 under *35 U.S.C. § 102(b)* as being anticipated by Melin *et al.*, and, the Examiner’s grounds for the rejection of claims 1-14 under *35 U.S.C. §*

103(a) as being unpatentable over Wareheim in view of Hull are no longer applicable and
Alter therefore respectfully requests that the Examiner withdraw these rejections.

Respectfully,

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